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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/807,894

03/24/2004

Robert H. Rines

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41840

7590

02/26/2008

RINES & RINES

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CONCORD, NH 03301

EXAMINER

SAADAT, CAMERON

ART UNIT

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3714

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/807,894	Applicant(s) RINES, ROBERT H.	
	Examiner CAMERON SAADAT	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/7/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/23/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to preliminary amendment filed 10/7/2004, claims 1-31 are pending in this application.

Information Disclosure Statement

The information disclosure statement filed 2/23/2006 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The antecedent basis for "the facility" has not been clearly set forth.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the

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conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Independent claims 1, 8, 9, 20-21, and 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over independent claims 1, 2, 7, and 14-15 of copending Application No. 10/948,840 in view of Blume (US 2004, 0023200).

Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. Both applications claim a method and system for supplementing the materials of various passages of a printed book with visual and audio materials. The instant application claims an electronic reader, such as a barcode reader, to actuate the visual and audio materials when a reader scans coded indicia. Copending application No.

10/948,840 discloses all of the claimed subject matter of the instant application, with the exception of claiming the feature of voice-actuation of the visual and audio materials. However, it is the examiner's position that voice actuation is old and well known for executing commands. In addition, Blume teaches a method and system for supplementing a book with audio and video, wherein speech-recognition is utilized to allow a reader to retrieve audio/video data by speaking the name of a book title. Thus, in view of Blume, it would have been obvious to one of ordinary skill in the art to modify the method of actuating audio/video data, by utilizing voice-recognition, in order to free a user's hands of devices such as optical readers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-14, 16, and 20-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Blume (US 2004, 0023200).

Regarding claims 1, 8, 9, 20-21, and 24, Blume discloses a system and method for supplementing the materials of various passages of different printed book descriptive materials, with visual and supplemental materials, related to the specific subject matter of the passages of printed descriptive materials (see ¶ 20), that comprises, electronically storing on tracks of a recorded storage medium

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pluralities of the visual and audio supplemental information (See ¶ 34), and each provided with accessing coding specific to each such track of the medium; printing on the pages of the book alongside each of the various descriptive material passages, and an electronically readable code indicia corresponding specifically to that coded track of the medium containing the recorded specific visual/audio supplemental material (see ¶ 28); providing an electronic wand 14 for remotely selectively accessing the respective tracks of a medium player available to the book reader, and controlling the visual/audio playing of the same for displaying/reproducing to the reader said supplemental visual information recorded on the respective tracks; and further providing to the book reader an electronic reader (optical scanner 34) of said coded indicia, adapted to actuate the electronic wand to playback respective coded tracks of the medium in the player in accordance with the book reader applying the electronic indicia reader to the respective code indicia in the book (See ¶ 23-24), thereby providing the book reader with audio/video supplemental material while reading.

Regarding claims 2 and 10, Blume discloses electronically readable code indicia applied in the book to the unprinted margins or spaces of the book pages near the corresponding printed passages. (See ¶ 28, 32).

Regarding claims 3 and 11, Blume discloses a method wherein the book reader's application of the electronic code indicia reader 34 to a selected book coded indicia automatically actuates the wand 14 in turn to actuate the player to select and play the respective recorded track on the medium corresponding to the book reader's selected book indicia. See ¶ 23-24.

Regarding claims 4 and 12, Blume discloses a portable, hand-held electronic reader 34 in wired communication with the wand 14, and the wand is in wired, remote or wireless communication with the player. See ¶ 21.

Regarding claims 5 and 13, Blume discloses an electronic reader 34 and wand 14 that are integrally packaged. See Fig. 4.

Regarding claims 6 and 14, Blume discloses an electronic reader 14 provided with the book 12. See Fig. 1.

Regarding claim 16, Blume discloses that the reader 34 and the wand 14 are packaged in the form of a hand-held stylus. See Fig. 4.

Regarding claims 22 and 25, Blume discloses that the reader communication to the player of reader-selected indicia is effected by the reader initiating electronic reading of the indicia and communication thereof to the player. See ¶ 23-24.

Regarding claim 23, Blume discloses that the player is remote from the reader and the communication is wireless. See ¶ 21 and 37.

Regarding claim 26, Blume discloses that the indicia reading is effected by electronic scanning by the written material reader. See ¶ 23-24.

Regarding claim 27, Blume discloses a storage medium playback system that is remote from but visible to the reader of the written material, and the communication thereto is wireless. See ¶ 21 and 37.

Regarding claims 28, Blume discloses a storage medium comprising CD, CD player and display screen 54. See ¶ 35.

Regarding claim 29, Blume discloses various storage medium systems, including DVD. See ¶ 35.

Regarding claim 30, Blume discloses wherein the storage medium playback system comprises computer-accessible web storage and display screen. See ¶ 37.

Regarding claim 31, Blume discloses wherein the storage medium playback system comprises a computer 40 with internal storage and playback capability upon a display screen 54. See ¶ 34.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blume (US 2004, 0023200).

Regarding claim 17, Blume discloses a longitudinal shaped tool 14, but does not explicitly state that the tool is storable with the book. However, it is the examiner's position that it would have been obvious to one of ordinary skill in the art to store stylus 14 described in Blume with the book, since the book and stylus are utilized together.

Regarding claim 18, Blume discloses a hand-held tool that is connected by a cord to the book. See ¶ 21.

Regarding claim 19, Blume discloses a tool that is detachably connectable to the book. See ¶ 21.

Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blume (US 2004, 0023200) in view of Williams et al. (US 5,899,700; hereinafter Williams).

Regarding claims 7 and 15, Blume discloses optical scanner 34 and describes it as being similar to bar code readers and other optical scanning devices that are well known. See ¶ 28. Although implied, Blume does not explicitly disclose that the coded indicia comprise barcodes. However, Williams teaches a method and apparatus for providing multimedia material in response to a user scanning barcodes of a book. See Williams, col. 3, lines 3-27. Thus, in view of Williams, it would have been obvious to modify the optical scanner and coded indicia described in Blume, by providing coded indicia in the form of barcodes, in order to retrieve supplemental multimedia information for a book.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kim et al. (US 2005/0053906) – disclose an audio book comprising barcodes.
- Oh (US 6,416,326) – discloses a book coupled to an audio/video system.
- Lo (US 6,089,943) – discloses a book comprising barcodes
- Kimball (US 5,059,126) – discloses a learning system comprising a smart wand and a plurality of barcodes.
- Blume (US 6,915,103) - discloses a system and method for enhancement of books and other reading materials.
- Lemelson et al. (US 5,945,656) - discloses a generating audio in response to scanning coded data in a book.
- Marggraff et al. (US 7,299,971) – disclose an interactive print media including selectable printed matter elements.
- Blotkey et al. (US 6,788,283) - disclose a book with electronic display.
- Rathus et al. (US 6,164,534) - disclose electronic media combined with printed matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAMERON SAADAT whose telephone number is (571)272-4443. The examiner can normally be reached on M-F 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cameron Saadat/
Patent Examiner Art Unit 3714
February 11, 2008